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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1963

No. 579

In the Matter of the Application of

FRIEDRICH GRUSCHWITZ AND
ALBERT FRITZ, *Petitioners,*

For Spray-Plastering-Device for Applying Mortar to Ceilings and Walls of Buildings

## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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Petitioners pray that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals, entered in the above entitled case on July 26, 1963.

### OPINIONS BELOW

The Patent Office Examiner's final rejection (R. 21-22), the Examiner's Answer (R. 31-32) to petitioner's brief on appeal in the Patent Office, and the

opinion of the Patent Office Board of Appeals (R. 32-45) are unreported and appear in the printed record. The majority opinion of the Court of Customs and Patent Appeals and the dissenting opinions of Judges Rich and Smith, printed in Appendix A hereto, are reported in 320 F. 2d 401.

## JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on July 26, 1963. *Infra*, p. 7a. The jurisdiction of this Court is invoked under 28 U.S.C. § 1256.

## QUESTION PRESENTED

Whether 35 U.S.C. § 142, which states that a party seeking to appeal an adverse determination of the Patent Office Board of Appeals to the United States Court of Customs and Patent Appeals must file in the Patent Office his reasons of appeal specifically set forth in writing, is to be narrowly construed so as to bar consideration on the merits of an appeal where the reasons of appeal are set forth in writing and, as a practical matter, do fully apprise the Commissioner of Patents and the Court of Customs and Patent Appeals of the points at issue.

## STATUTES INVOLVED

28 U.S.C. § 1256, 62 Stat. 928. Court of Customs and Patent Appeals; certiorari.

> "Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari."

35 U.S.C. § 142, 66 Stat. 802. Notice of Appeal

> "When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner,

and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints."

## STATEMENT

On December 22, 1960, the Patent Office Examiner filed a final rejection refusing to grant petitioners Gruschwitz and Fritz a patent covering their invention of a Spray Plastering-Device for Applying Mortar to Ceilings and Walls of Buildings. R. 21-22. The Examiner based his decision on a finding that a patent application had been filed in Germany more than one year prior to the date of filing in the United States and concluded that such filing constituted a statutory bar to the issuance of a patent. The Patent Office Board of Appeals affirmed the decision of the Examiner on August 1, 1961 (R. 32-45), and pursuant to 35 U.S.C. §§ 141-144, petitioner appealed to the Court of Customs and Patent Appeals on October 31, 1961.

In connection with appeals taken to the Court of Customs and Patent Appeals, Section 142 of 35 U.S.C. provides, in part:

> "... the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal specifically set forth in writing ...."

In the instant case, the petitioners filed a Notice of Appeals with the Commissioner of Patents (R. 46), setting forth the following reasons of appeal.

> "1. It was error to affirm the decision of the Examiner in his rejection of claims 10 to 16."
>
> "2. It was error to refuse to allow the rejected claims."

The Court of Customs and Patent Appeals dismissed the appeal, holding that the petitioners had failed to satisfy the requirement of Section 142 that the reasons of appeal be specifically set forth in writing. The opinion below was written by Chief Judge Worley and concurred in by Judge Jackson. Judge Martin, in a separate opinion, concurred in the result. Judge Martin stated that the reasons of appeal given by the petitioners in the instant case, while sufficient on another set of facts, were here insufficient because "... there are several dates involved, any one of which could be determinative of the issues here presented ..." *Infra*, p. 8a. In the opinion of Judge Martin, the petitioner's reasons of appeal were insufficient solely because they failed to set forth petitioner's position as to the Patent Office Board of Appeals' disposition of the various dates in question.

Judge Rich and Judge Smith dissented in separate opinions. In an extensive opinion, Judge Rich noted what he believed was an inconsistency between the instant case and several similar cases recently decided. He characterized the opinion of the majority as a retreat "... into the barren world of useless legal technicalities from which we [the court] were so hopefully emerging." *Infra*, p. 10a.

## REASONS FOR GRANTING THE WRIT

The decision below involves an important question of federal law which has not been, but should be, settled by this Court because of its impact on the effective administration of justice by the Court of Customs and Patent Appeals and because of its impact on the scores of patent applicants who annually appeal adverse determinations of the Patent Office Board of

Appeals. In addition, the decision of the Court below is wrong and has so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

1. The requirement of Section 142 that reasons of appeal be specifically set forth in writing originated with Section 11 of the Patent Act of March 3, 1839 and has formed a part of the law since that date. This requirement has been given, in the words of Judge Rich, dissenting below, ". . . a bewilderingly inconsistent construction, sometimes fiercely literal and restrictive, sometimes inexplicably liberal, most of the time accepting the reasons presented to it without comment because their sufficiency was not challenged. *Infra*, p. 11a. In the language of Judge Smith, discussing this precise point, ". . . the often contradictory opinions of this court . . . present one of the most confused and perplexing situations imaginable." *In re Timmerbeil*, 320 F. 2d 413, 418.

The importance of the decision below is apparent from the narrow and overly technical view it takes of Section 142 and from its practical impact on the administration of justice. The interpretation given to this procedural provision by the court below is so constricted as to annually preclude consideration on the merits of cases of importance not only to the parties concerned, but also to all persons beneficially interested in the effective implementation of the patent laws.

The exhaustive dissenting opinion of Judge Rich in the instant case clearly points to the need for a final determination by this Court of the procedural point here at issue. The Appendix to Judge Rich's dissenting opinion (*Infra*, p. 23a) sets forth ninety-two cases

in which the Court of Customs and Patent Appeals has rendered a decision dealing with the requirements of Section 142 and clearly demonstrates that the question at issue has been, over an extended period of time, troublesome and time consuming to the Court of Customs and Patent Appeals and litigants alike.

A comparison of the instant case and one so recently decided as *In re Arnold and Brandt*, 315 F. 2d 951 (decided on April 25, 1963), clearly reveals the confusion engendered by the inconsistent decisions of the Court of Customs and Patent Appeals on this point. In *In re Arnold and Brandt*, *supra*, the reasons of appeal set forth by the appellant were as follows:

> "1. It was error to affirm the decision of the Examiner in his rejection of Claims 18 to 28.
>
> "2. It was error to refuse to allow the rejected claims." 315 F. 2d 951, 952."

The Court of Customs and Patent Appeals held that the above-quoted reasons of appeal complied with Section 142 noting, however, that its decision ". . . appears to be somewhat inconsistent with In re Dichter, 110 F. 2d 664, 27 CCPA 1060." *Ibid.* In the instant case, the Court of Customs and Patent Appeals, relying primarily on *In re Dichter*, 110 F. 2d 664, held that the following reasons of appeal fell short of the statutory standard set by Section 142:

> "1. It was error to affirm the decision of the Examiner in his rejection of claims 10 to 16.
>
> "2. It was error to refuse to allow the rejected claims."

From the above, it seems eminently clear that the patterns of decisions of the Court of Customs and

Patent Appeals, in fact, has led, in the words of Judge Rich ". . . to the utter bafflement of the bar, the dismay of the litigants, and the denigration of their attorney's professional reputation." *Infra*, p. 22a.

This Court's responsibility for the proper functioning of the federal judiciary extends to the Court of Customs and Patent Appeals. See *Glidden Company v. Zdanok*, 370 U.S. 530. This responsibility requires that a clear standard to be established to guide litigants in this area in lieu of the wavering and uncertain rule that currently prevails to the confusion of all parties concerned.

2. The decision of the court below involves an interpretation of Section 142 of 35 U.S.C., the statutory provision which governs all appeals taken by disappointed patent applicants to the Court of Customs and Patent Appeals. Any judicial interpretation of this provision is of critical importance to all persons bringing appeals to the Court of Customs and Patent Appeals from the Patent Office Board of Appeals.

For the fiscal year ending June 30, 1961, there were one hundred and forty-eight such appeals pending before the Court of Customs and Patent Appeals. *Annual Report of The Director of the Administrative Office of The United States Courts*—1961, p. 318 (1962). The decision of the Court below thus extends well beyond the petitioners in the instant case, and the rights and privileges of many unseen appellants may be affected if the rule of the majority is allowed to stand. Therefore, resolution of the question by this Court is in the public interest because of the significant number of appeals annually brought from the Patent Office Board of Appeals to the Court of Customs and Patent Appeals.

3. This Court's responsibility for the effective administration of justice within the federal judiciary requires that the archaic view of procedure espoused by the majority below be set aside.

The decision below seems clearly to clash with the wisdom of Mr. Justice Frankfurter's statement in *Indianapolis* v. *Chase National Bank, Trustee*, 314 U.S. 63, 69, that "Litigation is the pursuit of practical ends, not a game of chess." That litigants should not be denied their day in court for failure to satisfy procedural technicalities is today accepted as a jurisprudential precept. As Judge Rich said in discussing Section 142 in *In re LePage's Incorporated*, 312 F. 2d 455, 467, "The business of modern courts is to decide issues and settle disputes and not to make life unnecessarily difficult for litigants with no gain to itself."

The instant case, it is submitted, is one in which the Court of Customs and Patent Appeals has interpreted Section 142 in such a way as to ". . . make life unnecessarily difficult for litigants with no gain to itself." *In re LePage's Incorporated, supra.*

The petitioners, in their view of Section 142 align themselves with this Court which, in discussing the function of the Federal Rules of Civil Procedure, stated:

> "The Federal Rules reject the approach that pleading is a game of skill in which one misstep by counsel may be decisive to the outcome and accept the principle that the purpose of pleading is to facilitate a proper decision on the merits." *Conley* v. *Gibson*, 355 U.S. 41, 48.

It is the petitioner's belief that the decision of the court below is wrong and that the view of the role of

procedural rules implicit therein is archaic and outmoded and represents so significant a departure from the accepted and usual course of judicial proceedings as to call for the exercise by the Court of its power of supervision over the federal judiciary.

## CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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